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In re Application of  
Huang, et al. :  
Application No. 09/751,945 :  
Filing Date: 29 December, 2000 :  
Attorney Docket No. H16-26156-01 (256.078US1) :

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**OFFICE OF PETITIONS**

This is a decision on the petition filed on 19 April, 2004, to revive the instant application 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) **DISMISSED**, and no fees are charged.

**BACKGROUND**

The record reflects that:

- it appeared Petitioner failed to reply timely and properly to the final Office action mailed on 25 June, 2003, with reply due absent extension of time on or before 25 September, 2003;
- Petitioner filed an after-final amendment (over a 25 August, 2003, certificate of mailing) on 28 August, 2003, however, it was deemed by the Examiner not to be a proper reply to the final Office action;<sup>1</sup>

<sup>1</sup> The proper response to the final Office action (see: MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a Continuing Application or Request for Continued Examination (RCE) (with fee and submission) under 37 C.F.R. §1.114.

- on 5 January, 2004, Petitioner filed a Notice of Appeal (over a Monday, 29 December, 2003, certificate of mailing (Thursday and Friday, 25 and 26 December, 2003, having been Federal holidays)), with an authorization for required fees (such as extensions of time)—however, it does not appear that the Office acted upon this fee authorization to make timely the reply;
- on 23 January, the Examiner mailed an Advisory Action indicating that the after-final amendment did not place the application in condition for allowance and would not be entered for purposes of appeal;
- on 4 March, 2004, Petitioner filed an Appeal Brief (in triplicate with fee), with a fee authorization (and, thus, a request and fee for a one- (1-) month extension of time)—and the Office acted upon this authorization;
- the Office mailed a Notice of Abandonment on 12 March, 2004;
- Petitioner's submission includes, *inter alia*, Petitioner's statement that the Office appeared to have erred in the matter; and
- Petitioner has evidenced timely and proper reply (Notice of Appeal) to the Office action in question, and the holding of abandonment previously was withdrawn.

With regard to the proper timing for a reply in after-final practice, Petitioner is to directed to the commentary at MPEP §706.07(f) and (g), and the former reflects, in pertinent part, that:

**706.07(f) Time for Reply to Final Rejection [R-2 ]**

The time for reply to a final rejection is as follows:

\* \* \*

(A) . . . if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established. If the last day of "2 months of the date of the final Office action "falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, and a reply is filed on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday, pursuant to 37 C.F.R. §1.7(a), the reply is deemed to have been filed within the 2 months period and the shortened statutory period will expire at 3 months from the date of the final rejection or on the mailing date of the advisory action, whichever is later (see MPEP §710.05). In no event can the statutory period for reply

expire later than 6 months from the mailing date of the final rejection. (Emphasis added.)

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>)

#### Allegations as to Unintentional Delay

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

As indicated above, Petitioner has evidenced timely and proper reply (Notice of Appeal) to the Office action in question, and the holding of abandonment previously was withdrawn.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is dismissed as moot.

The file is forwarded to Technology Center 2100 to await the Examiner's Answer in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

  
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